

REMARKS

The Examiner has repeated the rejection of claims 1, 2, 4, 5, 18 and 19 under 35 U.S.C. § 102(b) in view of Kewin, the rejection of claim 20 under 35 U.S.C. § 103(a) in view of Kewin, and the rejection of claims 3 and 6 under 35 U.S.C. § 103(a) in view of Kewin and Adams. Further, the Examiner has rejected claims 1, 2, 4, 5 and 20 under 35 U.S.C. § 102(e) in view of the newly cited reference U.S. Patent No. 6,390,428 to Oshima (“Oshima”), and claims 3 and 6 under 35 U.S.C. § 103(a) in view of Oshima and Adams. Also, claims 1-6 and 19-20 have been rejected under 35 U.S.C. § 112, first paragraph.

I. Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 1-6 and 19-20 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Examiner maintains that the specification fails to reasonably convey to one skilled in the art that the claimed target is “not provided with electrical components.” The Examiner acknowledges that the specification never mentions that the target is provided with electrical components, but also maintains that the specification likewise never mentions that electrical components are *not* provided.

Applicant submits, however, that the recitation is fully supported by the specification. In particular, the specification discloses a non-limiting example where a “color” of a target indicates a type of sheet roll (pg. 12 of Application). For example, to determine the type of sheet roll, the specification discloses that a distance sensor may be capable of measuring a “color” of the target due to reflected light (pgs. 13 and 16 of Application). There is no disclosure of

electrical components being provided on the target. Rather, the only electrical component disclosed is the actual distance sensor. However, the distance sensor is not a component of the target. Further, one skilled in the art would clearly understand the concept of light reflection off of a colored surface (i.e. that no electrical component is needed on the colored surface).

Applicant submits that such non-limiting example allows persons of ordinary skill in the art to recognize that the inventors invented what is claimed. In other words, Applicant submits that one of ordinary skill in the art would understand that at least the above described non-limiting embodiment does not require the target to have electrical components, such that the inventors were in possession of the claimed invention as of the filing date (MPEP § 2163.02). Further, Applicant notes that the above-described non-limiting embodiment in no way narrows the scope of the claims. Rather, the non-limiting embodiment is described herein in order to show that the Applicant has possession of the claimed invention (i.e. “said target is not provided with electrical components”) at the time of filing.

II. Rejections under 35 U.S.C. § 102(b) in view of U.S. Patent No. 4,874,139 to Kewin (“Kewin”).

The Examiner has rejected claims 1, 2, 4, 5 and 19 under 35 U.S.C. § 102(b) as being anticipated by Kewin.

A. Claim 1

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites that a target is configured to provide information to identify a type of a sheet roll. The “type” of sheet roll comprises at least one of a material of the sheet roll, a thickness of the material, a width of the material, a quantity of winding of the material, and a sensitivity of the material.

In the previous Office Action dated April 2, 2004, the Examiner maintained that the plug 26 of Kewin discloses the claimed target (i.e. pg. 5, line 7). However, in the current Office Action, the Examiner appears to maintain that the collar 14 discloses the claimed target (i.e. pg. 9, lines 12-15). Nevertheless, Applicant submits that claim 1 is patentable over the cited reference.

As set forth in the July 2, 2004 Amendment, the Kewin reference is not directed towards a determination of a “type” of the material, based on a target, as recited in claim 1. Rather, Kewin relates to providing a core member 12 having improved beam strength to reduce bending and distortion, and also to reduce flutter of paper supply at different rotational speeds (col. 1, lines 59-67; col. 4, lines 52-61).

On pg. 9 of the current Office Action, the Examiner maintains that collar 14 of Kewin discloses a target and the alleged target is mated with a plug 26, such that if the wrong paper roll is used, the plug 26 will not mate with the collar 14. However, Kewin fails to teach or suggest that different size collars and plugs are manufactured such that mating of the plug and collar will determine whether a particular sheet roll is correct for a printing press apparatus. Rather, the

reference merely discloses that the collar has set dimensions and the plug is molded to conform to the collar (col. 3, line 65 to col. 4, line 6; col. 6, lines 40-43). There is no teaching or suggestion of a plug that does not fit with a collar, or what such a problem would indicate.

Further, as stated in the July 2, 2004 Amendment, the plug 26 is used merely for gripping the core members 12 during shipping and storing (col. 4, lines 48-51; col. 5, lines 11-14). The plug 26 is removed before the sheet roll is inserted into stub-shaft chucks of a printing press (col. 1, lines 42-47; col. 4, lines 2-4 and 31-37). Therefore, Applicant submits that the Examiner's statements that the mating of the plug and collar would identify whether the particular sheet roll is compatible with the printing press, is not supported by the teachings of the reference (pg. 9 of Office Action). As such, it is not inherent that the collars 14 and plugs 26 are used to indicate a different "type" of material, as recited in claim 1 (as noted in the July 2, 2004 Amendment, evidence of inherency in a reference "must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added)).

Accordingly, since Kewin fails to teach or even suggest that the collar 14 and plug 26 are sized or shaped due to the "type" of material on the core member 12, but rather, the construction of the collar 14 is intended to improve the strength of the core member 12, Applicant submits that the identification of a "type" of material is not "necessarily present" in the Kewin reference.

In addition, the Examiner acknowledges that functional limitations must be evaluated and considered just like any other limitation of the claim for what they fairly convey to one of

ordinary skill in the art, but then refers to MPEP § 2114, and resolutely maintains that apparatus claims cover what a device is, not what a device does. However, in accordance with MPEP § 2173.05(g), the recitation of “identifying a type of the sheet roll”, defines a “particular capability or purpose that is served by the recited element...” Further, the recitation sets definite boundaries on the patent protection sought (MPEP 2173.05(g); *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971)). Applicant submits that the claimed recitations clearly convey to one skilled in the art the context in which the claimed target is used. Accordingly, Applicant submits that one skilled in the art would understand that the collar 14, which is used to improve the strength of the core member 12, does not inherently teach or suggest the claimed target.

Based on the foregoing, Applicant submits that claim 1 is patentable over the Kewin reference, and respectfully requests the Examiner to reconsider and withdraw the rejection.

B. Claims 2, 4 and 5

Since claims 2, 4 and 5 are dependent upon claim 1, Applicant submits that such claims are patentable at least by virtue of their dependency.

C. Claim 19

Since claim 19 contains features that are analogous to the features recited in claim 1, Applicant submits that claim 19 is patentable for at least analogous reasons as claim 1.

III. Rejections under 35 U.S.C. § 102(e) in view of U.S. Patent No. 6,390,428 to Oshima (“Oshima”)

The Examiner has rejected claims 1, 2, 4, 5 and 20 under 35 U.S.C. § 102(e) as being anticipated by Oshima.

A. Claim 1

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites that the target is colored.

The Examiner maintains that target 15 of Oshima discloses the claimed target. However, Oshima fails to teach that target 15 is colored. Accordingly, Applicant submits that claim 1 is patentable over the cited reference and respectfully requests the Examiner to reconsider and withdraw the rejection.

B. Claims 2, 4, 5 and 20

Since claims 2, 4, 5 and 20 are dependent upon claim 1, Applicant submits that claims 2, 4, 5 and 20 are patentable by virtue of their dependency.

IV. Rejections under 35 U.S.C. § 103(a) in view of Kewin and U.S. Patent No. 4,852,823 to Adams et al. (“Adams”)

The Examiner has rejected claims 3 and 6 under 35 U.S.C. § 103(a) in view of Kewin and Adams. However, claim 3 has been canceled without prejudice or disclaimer. Accordingly, the rejection of claim 3 is now moot.

In addition, since claim 6 is dependent upon claim 1, and Adams fails to cure the deficient teachings of Kewin, as set forth above, Applicant submits that claim 6 is patentable at least by virtue of its dependency.

V. Rejection under 35 U.S.C. § 103(a) in view of Kewin

The Examiner has rejected claim 20 as being unpatentable over Kewin. However, since claim 20 is dependent upon claim 1, Applicant submits that claim 20 is patentable over the cited reference at least by virtue of its dependency.

VI. Rejections under 35 U.S.C. § 103(a) in view of Oshima and Adams

The Examiner has rejected claims 3 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Oshima in view of Adams.

Since claim 3 has been canceled, without prejudice or disclaimer, Applicant submits that the rejection of such claim is now moot.

In regard to claim 6, Applicant submits that Oshima and the present application are both assigned to Riso Kagaku Corporation. Applicant asserts that the subject matter of Oshima and the claimed invention were subject to a common obligation of assignment pursuant to MPEP

Amendment under 37 C.F.R. § 1.111
U.S. Application No. 09/805,184

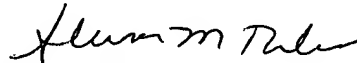
706.02(l)(2) and 35 U.S.C. § 103(c). This demonstration of common obligation of assignment removes Oshima as a reference, which in turn, overcomes the 35 U.S.C. §103 rejection of claim 6. Applicant encloses herewith assignment documents for Oshima (Reel 010565, Frame 0486, Date recorded 2/14/2000) and the current Application (Reel 011604, Frame 0331, Date recorded 3/14/2001).

VII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Allison M. Tulino
Registration No. 48,294

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: December 2, 2004